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| 10/505,174 | 08/31/2004 | Satoshi Kitani | 255234US6PCT | 7201 |

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| EXAMINER | |
| MEDE, ESTEVE | |

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| ART UNIT | PAPER NUMBER |
| 2137 | |

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|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
| 08/09/2007 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/505,174

Applicant(s)

KITANI ET AL.

Examiner

Esteve Mede

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 08/31/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Specification

1. The disclosure is objected to because of the following informalities: The applicant failed to layout the specification according to 37 CFR 1.177(b) guidelines (see below for correct layout of the specification).

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

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The specification does not provide for the section heading as described above.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 5-6 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 5 discloses a program of a reproducing apparatus and an information processing apparatus for recording information to a recording medium. For the claim to be statutory the program must be implemented in a computer readable medium (storage). The claim as read can be considered by one of ordinary skill in the art as software per se, and therefore does not appear to be implemented in a computer readable medium (storage).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 5, 7, 9, 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Tagawa et al. (US 6,615,192 B1).

Regarding claims 1, 3, 5, 7, 9, 11, Tagawa discloses a signal processing system having a reproducing apparatus for reading information from a recording medium having information unique thereto and an information processing apparatus for mutually authenticating and connecting the reproducing apparatus through a transferring portion (col. 2, lines 4-16), wherein the reproducing apparatus comprises: final encryption key generating means for generating a content information encryption key in accordance with intermediate key information. According to CPRM a "title key" is serve as the "final key" (col. 1, lines 29-48); a first transmitting portion for transmitting the intermediate key information to the information processing/apparatus through the transferring portion (see figure 4 of the drawings; col. 1, lines 61-67; col. 2, lines 1-4); and a second transmitting portion for transmitting the content information encryption key to the information processing apparatus through the transferring portion (see figure 4 of the drawings; col. 1, lines 61-67; col. 2, lines 1-4), and wherein the information processing apparatus comprises: a content information encrypting portion for encrypting content information using the content information encryption key (col. 1, lines 29-37); an intermediate key information encrypting portion for encrypting the intermediate key information using key information unique to the recording medium, the key information being generated in accordance with information unique to the recording medium (col. 1, lines 39-45); and a recording portion for recording the encrypted content

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information and the encrypted intermediate key information to the recording medium (col.1 lines 29-48).

Regarding claim 13, Tagawa discloses a reproducing apparatus, comprising: at least one of a recording portion for recording encrypted data to a recording medium on which first information for invalidating an illegal electronic device, second information that differs in each content, third information definable for each encrypted unit, and identification data that differs in each stamper are pre-recorded and a reproducing portion for reproducing encrypted data recorded on the recording medium (see Figure 12-13 of the specification; col. 1-67); a storing portion for storing fourth information unique to a valid electronic device or application software; a revoking processing portion for determining whether or not the forth information is information unique to a valid electronic device or application software using the first information and the fourth information (see Figure 12-13 of the specification; col. 1-67); a calculating portion for obtaining intermediate key information unique to each recording medium using the first information, the fourth information, the second information, and the identification data when the determined result of the revoking processing portion represents that the fourth information is information unique to a valid electronic device or application software; and a transmitting portion for transmitting the intermediate key information to the final encryption key generating portion of an information processing apparatus through a transferring portion (see figure 12-13 of the specification; col. 11, lines 1-67).

Regarding claim 14, Sagawa discloses the recording and reproducing apparatus further comprising: an authenticating portion for mutually authenticating a data processing apparatus for at least encrypting data or decrypting encrypted data using a key generated in accordance with the intermediate key information (see Figure 1a-1b of the drawings; col. 1, lines 60-67; col. 2, lines 1-16); and an intermediate key information encrypting portion for encrypting the intermediate key information using a session key generated when the authentication has been successfully performed and transmitting the encrypted intermediate key information to the data processing apparatus (see Figure 1a-1b of the drawings; col. 1, lines 60-67; col. 2, lines 1-16).

Regarding claim 15, Tagawa discloses a data processing apparatus, comprising: an authenticating portion for authenticating a recording and reproducing apparatus, the recording and reproducing apparatus having fourth information unique to a valid electronic device or application software, for at least recording encrypted data to a recording medium on which first information for invalidating an illegal electronic device, second information that differs in each content, third information definable for each encrypted unit, and identification data that differs in each stamper are pre-recorded or reproducing encrypted data recorded on the recording medium (col. 1, lines 60-67; col. 2, lines 1-67; see Figure 12-13 of the specification); a key information decrypting portion for receiving the first information, the fourth information, and intermediate key information from the recording and reproducing apparatus and decrypting

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the intermediate key information, the first information and the forth information having been encrypted using a session key generated when the authentication has been successfully performed, the intermediate key information being unique to each recording medium and generated using the second information and the identification data (col. 1, lines 29-67; col. 2, lines 1-67); a final encryption key generating portion for generating a final encryption key using the third information received from the recording and reproducing apparatus and the decrypted intermediate key information; and an encrypting and decrypting portion for at least encrypting data using the final encryption key or decrypting data using the final encryption key. As described above, a final key according to CPRM specification is the same as the "title key" (col. 1, lines 29-67; col. 2, lines 1-67).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2,4,6,8,10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagawa et al. (US 6, 615, 192 B1) in view of Kojima et al. (JP 2002-348925).

Regarding claim 2, 4, 6, 8, 10 and 12, Tagawa discloses all the limitation of claim 2, except wherein the reproducing apparatus further comprises a

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random number generating portion for generating a random number, and wherein the intermediate key information is a random number generated by the random number generating portion.

Kojima discloses a reproduction apparatus further comprises a random number generation portion for generation a random number and wherein the intermediate key information is a random number generated by the random number generating portion (para. 0029, lines 1-11).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tagawa to include the use of a reproducing apparatus having a random number generator, and the title key is randomly generated by a random number generator in order for the recording device and the reproducing device to communicate securely over unsecured channels, such that unauthorized parties would be unable to obtain content transferred between the recording device and the reproducing device, and to able to assign different title keys for each group of contents.

Conclusion

7: Any inquiry concerning this communication or earlier communications from the examiner should be directed to Esteve Mede whose telephone number is 571-270-1594. The examiner can normally be reached on Monday thru Friday, 8:30-5:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Esteve Mede

EM

August 2, 2007


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER